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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

CHAUDHURI, ANITA

ART UNIT PAPER NUMBER

2173

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 09/828,868 | Applicant(s) CHAKRAVARTY ET AL. | |
| | Examiner Anita D. Chaudhuri | Art Unit 2173 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/26/2002, 2/15/2002</u> <u>RB</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to application number 09/828868 filed on 04/10/2001.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference number "507" has been used to designate both "storage portion" and "export portion" in FIG 5. It is assumed the reference number for the "storage portion" is "505" as mentioned in the specification.

The reference number "414" mentioned in the specification (page 11) is not labeled in any of the drawings; so is the reference number "901" (page 15).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract is objected to because of being too long. It should also be limited to one paragraph.

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Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and limited to a single paragraph on a separate sheet within the range of 50 to 150 words. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 28 and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain "derivative digital asset" which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 63 is rejected under 35 U.S.C. 112, second paragraph; Claim 63 recites the limitation "the selected digital clips from the database, including means for retrieving a corresponding meta file from the database, and means for retrieving a corresponding

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video from the streaming video server data store" in Claim 60. There is insufficient antecedent basis for this limitation in the claim.

It is assumed that the Claim 63 is meant to depend on Claim 58 as in similar Claims 19 and 41.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-8, 10-24, 26-30, 32-46, 48-52, 54-66 are rejected under U.S.C. 35 as being anticipated by U. S. Patent number 6,882,793 attributed to Fu et al. (hereafter referred to as Fu).

Regarding Claim 1's "providing a storage having a plurality of digital assets, wherein at least a portion of the digital assets are digital stream, each of the digital assets including at least one digital clip, each digital clip having a plurality of frames including one key frame corresponding to the digital clip", Fu discusses about storing the digitized video, scene detection information and encoded streaming versions of the digitized video (column 12, line 62-67).

With respect to “selecting, from the plurality of digital assets, a plurality of digital clips as a storyboard”, Fu teaches how to select clips from the clip frame and include it in the storyboard frame (column 14, line 3-27).

Regarding “transmitting, to a computer screen, an electronic signal representing a display corresponding to the storyboard, the display presenting an image for the key frame corresponding to each of the plurality of digital clips of the storyboard; wherein the image is a low-resolution image representing the key frame for at least one digital clip of the plurality of digital clips; wherein the image further includes (i) a title associated with the at least one digital clip, (ii) and a timing of the at least one digital clip”, Fu discloses how the user can view a streaming version (which can be a low resolution version of the original digitized content) of a clip, storyboard or album (column 10, line 48-63). Fu also notes displaying the clip with title, and timing of the clip (FIG 5I, FIG 5H; column 17, line 11- 27).

With respect to “modifying the storyboard, including (i) adding, responsive to a user add request, at least a portion of an other digital asset of the plurality of digital assets, to the plurality of digital clips as the storyboard; (ii) deleting, responsive to a user delete request, one of the plurality of digital clips from the storyboard; (iii) re-ordering, responsive to a user re-order request, an order of the digital clips in the storyboard; and (iv) storing, responsive to a user save request, the storyboard”, Fu teaches how a storyboard can be modified (FIG 5B).

Regarding “modifying at least one of the digital clips in the storyboard, including (i) adjusting, responsive to a user request, a beginning time for at least one of the digital

clips; (ii) adjusting, responsive to a user request, an end time for at least one of the digital clips; and (iii) storing, responsive to the user request, the adjusted time for at least one of the digital clips”, Fu discusses about trimming a scene (FIG 5I).

With respect to “playing the storyboard, including playing each digital clip in the storyboard in sequence”, Fu notes how a “playlist editor” can be used to allow the user to play the content of the album that sequences through some or all the content of the album in the order specified by the user (column 19, line 23-62).

As per Claim 2, Fu discloses how the user can develop a finished product which can be referred to as an album by adding clips to the storyboard and then how the user can make it public if she/he chooses to do so (column 4, line 32-54).

Regarding Claim 4, Fu notes the preview functionality (column 4, line 23-31; column 14, line 42-57).

With respect to Claim 5, Fu discusses how a particular scene can be played (column 14, line 42-57).

Regarding Claim 6, Fu’s storyboard is derived from the scenes from the clip frames and it is saved in the database (column 14, line 26-41; column 4, line 41-45).

Referring to Claim 7, Fu notes on having different types of digital assets (column 19, line 1-8).

With respect to Claim 8, Fu discusses about storing scene, storyboard or album in the database (column 4, line 41-45).

Referring to Claims 10, 11, Fu explains how a plurality of representative thumbnail images for scenes can be stored in the image database, and how

alternatively, the clip frame can be used to display all the scenes associated with a previously created album (column 14, line 3-25).

Concerning Claim 12, Fu notes the association between the clips, key frame and the associated data (column 14, line 3-25).

With respect to Claims 13,14, Fu discusses about stored scenes in the database and the plurality of representative thumbnail images stored in the database (column 14, line 3-25; column 12, line 62-67).

Referring to Claim 15, Fu notes exporting the digital images, video clips (column 11, line 7-10).

Regarding Claim 16, Fu discusses importing digital assets (FIG 1, FIG 7).

With respect to Claim 17, Fu notes importing digitally encoded video file (FIG 7)

Regarding Claim 18, Fu discusses importing digital images using the browser (column 11, line 18-29; FIG 7)

Regarding Claim 19, Fu discusses accessing clip from the database (column 14, line 3-25; column 12, line 62-67), whereas database can be metafile.

With respect to Claim 20, Fu discloses importing streaming video version of the digitized content over the network and also encoding an analog video (column 5, line 18-39; FIG 7; column 10, line 57-61).

Concerning Claims 21, 22 Fu discusses about uploading video contents including both assets and properties (column 13, line 8-27).

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Claims 23, 24, 26-30, 32-44 lists all the same elements of Claims 1, 2, 4-8, 10-22, respectively, but in "system" form rather than "method" form. The rationale of rejecting Claims 1, 2, 4-8, 10-22 applies to Claims 23, 24, 26-30, 32-44 as well.

Claims 45, 46, 48-52, 54-66 lists all the same elements of Claims 1, 2, 4-8, 10-22 respectively, but in "system" form. The rationale of rejecting Claims 1, 2, 4-8, 10-22 applies to Claims 45, 46, 48-52, 54-66 as well.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 9, 25, 31, 47, 53 are rejected under U.S.C. 35 as being unpatentable over Fu in view of U.S. Patent number 6,154,600 attributed to Newman et al. (hereafter referred to as Newman).

Concerning Claim 3, Newman teaches the concept of having a plurality of storyboards (FIG 10).

It would have been obvious to one of ordinary person skilled in the art, having the teachings of Fu and Newman before him at the time the invention was made to have incorporated Newman's teaching's of plurality of storyboards into Fu's teaching for producing video content.

With respect to Claim 9, although Newman is not explicit about removing a selected storyboard, it would have been obvious to one of ordinary person skilled in the art, having the teachings of Newman plurality of storyboards before him at the time the invention was made, to incorporate the deletion of a storyboard functionality.

Claims 23-44 lists all the same elements of Claims 1-23 respectively, but in "system" form rather than "method" form. The rationale of rejecting Claims 1-23 applies to Claims 23-44 as well.

Claims 45-66 lists all the same elements of Claims 1-23 respectively, but in "system" form. The rationale of rejecting Claims 1-23 applies to Claims 45-66 as well.

Conclusion

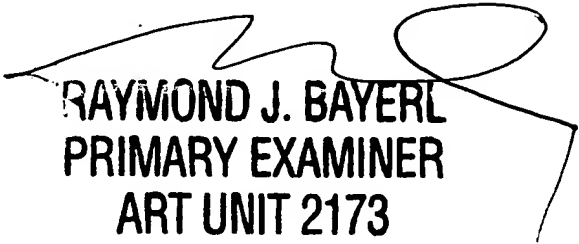
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita D. Chaudhuri whose telephone number is 5712721427. The examiner can normally be reached on Mon-Fri 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on 571 272 4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anita D. Chaudhuri
Art Unit: 2173
Date: 11/22/2005



RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173